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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,108	12/13/2001	Georg G. A. Bohm	P01012US1A	2477

7590

12/21/2005

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EXAMINER

MAKI, STEVEN D

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/022,108	Applicant(s) BOHM ET AL.	
	Examiner Steven D. Maki	Art Unit 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see advisory action attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-18.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see advisory action attachment.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

advisory action attachment

new issues

The new issues include:

(1) In claim 1, adding "where the processing aid includes a polar organic compound" without also reciting "... resin, a low molecular weight polymer, or a mixture thereof".

(2) New claim 21 which recites "polymer cement" but not latex and adds "where the processing aid includes a polar organic compound".

(3) New claims 26-31 which recite specified HLB such as "the polar organic compound is characterized by an HLB of from about 3 to about 35" (claim 26).

(4) New claims 32-37 which recite specified molecular weight such as "the polar organic compound is characterized by a molecular weight of from about 100g/mole to about 15,000 g/mole" (claim 32).

remarks

Applicant argues that one skilled in the art would not have chosen to substitute the non-elastomeric materials set forth on page 4 of Europe with one of the materials, particularly fatty acids or salts thereof, set forth in column 4 of Schultze. This argument is irrelevant since the issue is whether or not it would have been obvious to add a processing aid to Europe's latex *instead of* whether or not it would have been obvious to substitute Europe's non-elastomeric materials with fatty acid or salts thereof. See bottom of page 3 of office action dated 10-19-05.

Applicant argues that Europe teaches against "softeners, tackifiers, and plasticizing substances" because Europe discloses that the non-elastomeric particles are "relatively hard". This argument is not persuasive since (1) Europe teaches toward intimately associating the non-elastomeric particles with the elastomeric particles (page 2 last three lines) and in particular teaches depositing the non-elastomeric particles on the elastomer to form composite particles (page 3 lines 1-3, 15-17, page 6 lines 10-15) and (2) Schultze, which discloses that the vulcanized liquid polybutadiene plasticizers can be "fairly tough, rubbery materials" (col. 3 lines 4-50), teaches that the plasticizers soften the vulcanizable elastomeric material and improve the tack of elastomers. One of ordinary skill in the art would have desired such softening and increased tack of the elastomeric material since Europe teaches depositing the non-elastomeric particles on the elastomeric particles instead of using non-tacky elastomeric particles to prevent deposition of the non-elastomeric material on the elastomeric material.

Applicant argues that Lawson cannot be logically combined with Europe and Schultz since Lawson teaches anionically synthesizing monomer with an organic solvent whereas Europe 250 and Schultz relate to latexes. This argument is not persuasive since Schultz suggests using elastomeric material which has already been polymerized (e.g. page 7 lines 15-17), which corresponds to the resulting elastomeric polymer of Lawson obtained for example by coagulation and drum drying as explained at col. 13 lines 29-32.

With respect to applicant's comments on Patton, at least one of Schultz and Baranwal motivate one of ordinary skill in the art to add a processing aid (e.g. fatty acid,

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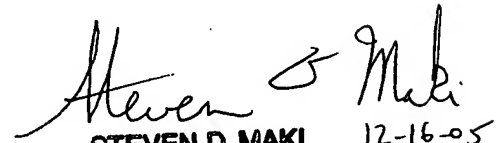
oil) to a latex /solution before mixing in a Banbury mixer so as to facilitate Patton's process of mixing crude rubber *and* carbon black in the Banbury mixer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
December 15, 2005


STEVEN D. MAKI
PRIMARY EXAMINER
12-16-05